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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,651	02/29/2000	MASANORI KAMATA	P18896	2074
7055	7590	08/16/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/514,651	Applicant(s) KAMATA, MASANORI	
	Examiner King Y. Poon	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-52 is/are pending in the application.
- 4a) Of the above claim(s) 37-43,45,46,51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) 35,36,44 and 47-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 37-43, 45, 46, 51, 52 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/2/2006.

2. Applicant's election with traverse of the restriction requirement in the reply filed on 6/2/2006 is acknowledged. The traversal is on the ground(s) that 1) page 1, lines 14-20, is part of the description of related art and does not include disclosure as identified as species; 2) species II and species III are each directed to a common embodiment shown in a single figure; 3) the species are not mutually exclusive such that the claims which read on such species do not overlap in scope; and 4) there are no serious burden exist in examining species I, II, and III. This is not found persuasive because:

1) The selected species requires: when the copy mode is set and when the numerical value input by the panel exceed the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode. The examiner has reviewed and considered the specification and drawings carefully and in detail and cannot locate such limitations in applicant's detail description of the preferred embodiment supported by drawings. Such limitation, at best is describe in the description of prior art section (page 1, lines 20-25, when a facsimile transmission number is input in the copy mode, the system automatically switch the mode). E.g., S5, fig. 3 of applicant's invention clearly disclosed that when the copy mode is set and when the numerical value input by

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the panel exceed the display capacity of the screen in the copy mode, DO NOT switches from the copy mode to the facsimile mode. The switch is when a pause key has been entered by the applicant, not when the numerical value input by the panel exceed the display capacity of the screen in the copy mode. Therefore, it appears to the examiner that the applicant is trying to claim the related prior art invention or at least an invention that contradicts applicant's invention of fig. 3 (nowhere does fig. 3 suggest or even possible to switch the mode relating to inputted digits at S4 or S9; this is a mutually exclusive properties), thereby, species I can be restricted from at least the applicant's invention of fig. 3 that is clearly directed to species II and III.

2) Species directed to a single embodiment can be restricted. An example of a common embodiment that has different species and each of the common embodiment and individual species can be restricted is a combination (common embodiment) and sub-combinations (MPEP 802.1, 806.05(d)).

USC 112 second paragraph requires: the claims must set forth the subject matter that applicants regard as their invention. Claim 45 does not set forth the subject matter "the copy mode not to be switched to the facsimile mode when the input numerical value does not belong to the copy mode until predetermined character which is not a numerical value is inputted." Such limitation is being set forth in claim 46. Claims 45 set forth the limitation of "inhibiting starting printing when input value does not belong to the copy mode". Such limitation is not set forth in claim 46. Since the subject matter set forth by the applicants regarding as their inventions are different in different claims, applicant is claiming different inventions.

3) Furthermore, MPEP 2172.01, missing elements in the claims comply with 112 second paragraph when various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve INDEPENDENT PURPOSES. Therefore the claims which read on such species (species II and III) do not overlap in scope in regards to the different elements being claimed. Moreover, the copy mode either switch or not switch (one of the mutual exclusive example) when the entered value does not correspond to the copy mode.

4) search queries required by the examiner for species I and would not be required for species II and III are: "copy mode ...SWITCH...facsimile mode ...when ... (numerical or value or display) ...exceed..."

search queries required by the examiner for species II and would not be required for species I and III are: "copy mode ...(not switch or maintain) ...when ... (numerical or value or display) ...exceed... (inhibit or prevent) ...(print or copy)"

search queries required by the examiner for species III and would not be required for species I and II are: "copy mode ...SWITCH...facsimile mode ...when ... numerical...(include or contain or consist) predetermined character"

Therefore, there would be a serious burden on the examiner if restriction is not required. (MPEP 808.02 (c)).

The requirement is still deemed proper and is therefore made FINAL.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation "when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode" (and the relationship of new drawing(s) with respect to fig. 3 if applicant believes that elected species I is related to the invention of other non-elected species) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 35, 36, 44, 47-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 35: The limitation “a controller which, when the copy mode is set and when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode” is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 44: The limitation “switching from the copy mode to the facsimile mode, when the input numerical value exceeds the display capacity of the screen in the copy mode” is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 36, 47-50: Claims 36, 47-50 are rejected under 35 U.S.C. 112, first paragraph because they depend on rejected claims 35, 44.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 35, 36, 44, 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunai (US 5,357,350).

Regarding claims 35, 44: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode (STP1, fig. 4) and a facsimile mode (STP7, fig. 4), the image recording apparatus comprising; a panel section (column 5, line 18) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of a number of copies (column 6, lines 66-67, column 7, lines 1-2) in the copy mode and a telephone number of a destination in the facsimile mode (column 7, lines 3-10); a display section (18e, fig. 2A, 2B, column 5, lines 19-21) which selectively displays (STP 8, fig. 4, STP 34, fig. 5) one of a screen for the copy mode and a screen for the

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facsimile mode, a display capacity of the screen in the copy mode being smaller than a display capacity of the screen in the facsimile mode (STP6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode (STP7 fig. 4), switches from the copy mode to the facsimile mode.

Regarding claim 36: Matsunai teaches wherein the display capacity of the screen, when the input numerical value corresponding to the number of copies is displayed, is smaller than the display capacity of screen, when the input numerical value the screen, when the input numerical value corresponding to the telephone number of the destination is displayed (STP6, fig. 4).

Regarding claims 47, 48: Matsunai teaches wherein the controller is configured to switch to the facsimile mode in response to the numerical value exceeding the display capacity of the screen in the copy mode (STP 6, STP 7, fig. 4).

Regarding claims 49, 50: Matsunai teaches the display comprising a single display region (the region of 18e that is displaying 003500 of fig. 2B) having a display capacity that changes in accordance with one of the copy mode and facsimile mode (fig. 4).

Response to Arguments

8. Applicant's arguments filed 11/8/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument that Matsunai does not teach when the numerical value input by the panel exceeds the display capacity of the screen in the copy mode, switches from the copy mode to the facsimile mode, has been considered.

In reply: Column 5, lines 2-20 clearly teaches display of a copy number, magnification number which is limited to 5, as disclosed in fig. 4, STP6-STP8. To the machine of Matsunai, the number 4 is a copy value and the machine would copy according to fig. 4. Fig. 4 controls the display capacity of the copy mode.

Page 7 lines 10-15, applicant's specification, teaches "the threshold value for input digits is set at two to allow only two digits to be displayed, even if an entry is made three times, only two digits are displayed." Page 7, lines 10-15 does not teach if an entry is made three times, only two digits are displayed and the mode is switched. Page 7, lines 15-27 teaches the function of the pause key used to retain a value entered by a user with respect to an entry is made three times, and the function of the pause key is clearly disclosed in fig. 3.

Fig. 3 clearly shows that the mode switching section 24 subsequently switches the mode from the copy mode to the facsimile mode (S8) after the pause key has been entered and not switches the mode from the copy mode to the facsimile mode when an entry is made three times.

Therefore, the examiner interprets the display capacity of the copy mode, is how many digits entered by a user that the display would show during a copy mode. The digits are limited to 4 according to fig. 4 of Matsunai.

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With respect to applicant's argument that Matsunai does not teach selectively display, has been considered.

In reply: STP 7, STP8, fig. 4, STP 33 and STP 34, fig. 5 of Matsunai teaches selectively display a fax mode or a copy mode respectively.

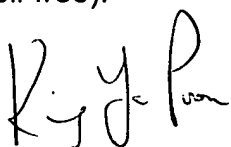
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 27, 2006


KING Y. POON
PRIMARY EXAMINER